

OLD DOCKET NO: DB3 - NEW DOCKET NO: OSEM-DB3

IN RE APPLICATION OF: Braddock Examiner: KANG

SERIAL NO: 09/636,484 GROUP ART UNIT: 2811

FILED: 08/10/00

TITLE: INTEGRATED TRANSISTOR DEVICES

TO: ASSISTANT COMMISSIONER OF PATENTS

37 CFR 1.181 PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Sir: The applicant petitions for reinstatement of claims finally withdrawn by the examiner.

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forming a semiconductor wafer on the second layer, and then removing the temporary substrate" **is covered by withdrawn method claim 53.** Claim 53 contains no order specificity as to its steps. Claim 53 recites:

53. A method for forming an enhancement mode metal-oxide-compound semiconductor field effect transistor structure, comprising:
providing a compound semiconductor wafer structure having an upper surface;
depositing a gate insulator structure comprising depositing a first layer and depositing a second layer, said gate insulator on said upper surface;
said first layer substantially comprising compounds of gallium and oxygen;
said second layer comprising at least one compound of gallium, oxygen and at least one rare earth element; and
depositing a gate electrode positioned on said gate insulator structure.

Claim 53 does not specify a temporal sequence of its recited steps. Thus, claim 53 does not preclude use of a temporary substrate which is removed after deposition of the electrode and gate insulating layers. Thus, the only basis upon which the examiner relies for his legal conclusion that claims 53-55 are independent and distinct is factually incorrect.

For all of the foregoing reasons, the restriction requirement is improper and should be withdrawn.



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TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Neifeld IP Law Docket No.: OSEM-DB3
Application Serial No.: 09/636,484
Filed: 08/10/00
Inventor: David Braddock
Title: Integrated Transistor Devices

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MAR - 7 2003
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OFFICE OF PETITIONS

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.181 PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Our check in the amount of \$130.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106. A duplicate copy of this sheet is enclosed.



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3/1/03
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I. **Statement of Relief Requested**

The applicant petitions to have withdrawn claims 53-55 reinstated.

II. **Material Facts**

On 7/15/2002, the PTO mailed an office action in which the examiner withdrew claims 53-55.

On November 14, 2002, the applicant filed a combined appeal brief and request to have claims 53-55 reinstated.

On 1/30/2003, the PTO mailed an office action reopening prosecution and making the withdrawal of claims 53-55 final.

A check for the petition fee is enclosed herewith.

III. **Reasons Why The Petition Should be Granted**

A. **Introduction**

The restriction is improper for two reasons. First, the examiner has failed to show any burden in examining the withdrawn claims. Second, the examiner has failed to show that the withdrawn claims are independent and distinct.

B. **Failure to Show Any Burden in Examining**

First, the examiner has not shown why claims 53-55 should be classified differently than claims 1-52. Claims 53-55 are method claims, but independent claim 53 is an analog of structure claim 39 in which similar elements are recited. Claims 54 and 55 are dependent upon 53 and therefore cannot be independently restricted.

The examiner alleges that the withdrawn claims are classified differently than the examined claims. The examiner presents no other fact supporting a burden in examination.

The similarity of the examined and withdrawn claims shows that there would be no burden in examining claims 53-55. Specifically, withdrawn independent method claims 55 is identical to examined structure claim 39, except for step recitation of "providing" or "depositing" of the otherwise identical elements recited in claim 39.

C. **Failure to Show That the Withdrawn Claims Are Independent and Distinct**

Second, the examiner has not shown that claims 53-55 are independent and distinct, as required by 35 USC 121.

The examiner asserts that the structure claim 39 could be made by a materially different process than defined by method claim 53. The examiner specifies a process allegedly resulting in the same structure defined by claim 39 and *allegedly* distinct from the process of claim 53. That is the examiner's only basis supporting the conclusion that claim 39 and 55 are independent and distinct.

The examiner's assertion that the structure claim could be made by the process allegedly distinct from the process defined by claim 53 is incorrect. Process of manufacturing the structure of claim 39 that the examiner relies upon is in fact covered by method claim 55. Specifically, the examiner asserts that the group II invention could be made the process of "a reverse order such as that [sic] forming a gate electrode on temporary substrate, forming a second layer on the gate electrode, forming a semiconductor wafer on the second layer, and then removing the temporary substrate." However, the process of "a reverse order such as that [sic] forming a gate electrode on temporary substrate, forming a second layer on the gate electrode,